APPENDIX A

Title 5, United States Code

§ 1009. *Judicial review of agency action.*

Except so far as (1) statutes preclude judicial review or (2) agency action is by law committed to agency discretion—

(a) Right of review.

Any person suffering legal wrong because of any agency action, or adversely affected or aggrieved by such action within the meaning of any relevant statute, shall be entitled to judicial review thereof.

(b) Form and venue of proceedings.

The form of proceeding for judicial review shall be any special statutory review proceeding relevant to the subject matter in any court specified by statute or, in the absence or inadequacy thereof, any applicable form of legal action (including actions for declaratory judgments or writs of prohibitory or mandatory injunction or habeas corpus) in any court of competent jurisdiction. Agency action shall be subject to judicial review in civil or criminal proceedings for judicial enforcement except to the extent that prior, adequate, and exclusive opportunity for such review is provided by law.

(c) Acts reviewable.

Every agency action made reviewable by statute and every final agency action for which there is no other adequate remedy in any court shall be subject to judicial re-

view. Any preliminary, procedural, or intermediate agency action or ruling not directly reviewable shall be subject to review upon the review of the final agency action. Except as otherwise expressly required by statute, agency action otherwise final shall be final for the purposes of this subsection whether or not there has been presented or determined any application for a declaratory order, for any form of reconsideration, or (unless the agency otherwise requires by rule and provides that the action meanwhile shall be inoperative) for an appeal to superior agency authority.

(d) Relief pending review.

Pending judicial review any agency is authorized, where it finds that justice so requires, to postpone the effective date of any action taken by it. Upon such conditions as may be required and to the extent necessary to prevent irreparable injury, every reviewing court (including every court to which a case may be taken on appeal from or upon application for certiorari or other writ to a reviewing court) is authorized to issue all necessary and appropriate process to postpone the effective date of any agency action or to preserve status or rights pending conclusion of the review proceedings.

(e) Scope of review.

So far as necessary to decision and where presented the reviewing court shall decide all relevant questions of law, interpret constitutional and statutory provisions, and determine the meaning or applicability of the terms of any agency action. It shall (A) compel agency action unlawfully withheld or unreasonably delayed; and (B) hold un-

lawful and set aside agency action, findings, and conclusions found to be (1) arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with law; (2) contrary to constitutional right, power, privilege, or immunity; (3) in excess of statutory jurisdiction, authority, or limitations, or short of statutory right; (4) without observance of procedure required by law; (5) unsupported by substantial evidence in any case subject to the requirements of sections 1006 and 1007 of this title or otherwise reviewed on the record of an agency hearing provided by statute; or (6) unwarranted by the facts to the extent that the facts are subject to trial de novo by the reviewing court. In making the foregoing determinations the court shall review the whole record or such portions thereof as may be cited by any party, and due account shall be taken of the rule of prejudicial error. (June 11, 1946, ch. 324, § 10, 60 Stat. 243.)

EFFECTIVE DATE

Section effective three months after June 11, 1946, see section 1011 of this title.

Title 28, United States Code

§ 1361. *Action to compel an officer of the United States to perform his duty.*

The district courts shall have original jurisdiction of any action in the nature of mandamus to compel an officer or employee of the United States or any agency thereof to perform a duty owed to the plaintiff.

(Added Pub. L. 87-748, § 1(a), Oct. 5, 1962, 76 Stat. 744.)

35 U. S. C. 135. Interferences. (a) Whenever an application is made for a patent which, in the opinion of the Com-

missioner, would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be. The question of priority of invention shall be determined by a board of patent interferences (consisting of three examiners of interferences) whose decision, if adverse to the claim of an applicant, shall constitute the final refusal by the Patent Office of the claims involved, and the Commissioner may issue a patent to the applicant who is adjudged the prior inventor. A final judgment adverse to a patentee from which no appeal or other review has been or can be taken or had shall constitute cancellation of the claims involved from the patent, and notice thereof shall be endorsed on copies of the patent thereafter distributed by the Patent Office.

(b) A claim which is the same as, or for the same or substantially the same subject matter as, a claim of an issued patent may not be made in any application unless such a claim is made prior to one year from the date on which the patent was granted.

(c) Any agreement or understanding between parties to an interference, including any collateral agreements referred to therein, made in connection with or in contemplation of the termination of the interference, shall be in writing and a true copy thereof filed in the Patent Office before the termination of the interference as between the said parties to the agreement or understanding. If any party filing the same so requests, the copy shall be kept separate from the file of the interference, and made available only to Government agencies on written request, or to any person on a showing of good cause. Failure to file the copy of such agreement or understanding shall render permanently unenforceable such agreement or understand-

ing and any patent of such parties involved in the interference or any patent subsequently issued on any application of such parties so involved. The Commissioner may, however, on a showing of good cause for failure to file within the time prescribed, permit the filing of the agreement or understanding during the six-month period subsequent to the termination of the interference as between the parties to the agreement or understanding.

The Commissioner shall give notice to the parties or their attorneys of record, a reasonable time prior to said termination, of the filing requirement of this section. If the Commissioner gives such notice at a later time, irrespective of the right to file such agreement or understanding within the six-month period on a showing of good cause, the parties may file such agreement or understanding within sixty days of the receipt of such notice.

Any discretionary action of the Commissioner under this subsection shall be reviewable under section 10 of the Administrative Procedure Act.

United States Patent Office Rules of Practice in Patent Cases

Petitions and Action by the Commissioner

181. Petition to the Commissioner. (a) Petition may be taken to the Commissioner (1) from any action or requirement of any examiner in the ex parte prosecution of an application which is not subject to appeal to the Board of Appeals or to the court; (2) in cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Commissioner; and (3) to invoke the supervisory authority of the Commissioner in appropriate circumstances.

(b) Any such petition must contain a statement of the facts involved and the point or points to be reviewed and the action requested. Briefs or memoranda, if any, in support thereof should accompany or be embodied in the petition; and where facts are to be proven, the proof in the form of affidavits (and exhibits, if any) must accompany the petition.

(c) When a petition is taken from an action or requirement of an examiner in the ex parte prosecution of an application, it may be required that there have been a proper request for reconsideration (rule 111) and a repeated action by the examiner. The examiner may be directed by the Commissioner to furnish a written statement, within a specified time, setting forth the reasons for his decision upon the matters averred in the petition, supplying a copy thereof to the petitioner.

(d) No fee is required for a petition to the Commissioner except in the case of a petition to revive an abandoned application (rule 137) or for the delayed payment of a final fee (rule 317).

(e) Oral hearing will not be granted except when considered necessary by the Commissioner.

(f) Except as otherwise provided in these rules, any such petition not filed within sixty days from the action complained of, may be dismissed as untimely. The mere filing of a petition will not stay the period for reply to an Examiner's action which may be running against an application, nor act as a stay of other proceedings.

(g) Determination of petitions of various kinds may be delegated by the Commissioner to the Supervisory Examiners or to the Solicitor and Law Examiners.

182. Questions not specifically provided for. All cases not specifically provided for in these rules will be decided in accordance with the merits of each case by or under the authority of the Commissioner, and such decision will be communicated to the interested parties in writing.

183. Suspension of rules. In an extraordinary situation, when justice requires any requirement of these rules which is not a requirement of the statutes may be suspended or waived by the Commissioner in person on petition of the interested party, subject to such other requirements as may be imposed.

Interferences: Definition, Preparation, Declaration

201. Definition, when declared. (a) An interference is a proceeding instituted for the purpose of determining the question of priority of invention between two or more parties claiming substantially the same patentable invention and may be instituted as soon as it is determined that common patentable subject matter is claimed in a plurality of applications or in an application and a patent.

(b) An interference will be declared between pending applications for patent, or for reissue, of different parties when such applications contain claims for substantially the same invention, which are allowable in the application of each party, and interferences will also be declared between pending applications for patent, or for reissue, and unexpired original or reissued patents, of different parties, when such applications and patents contain claims for substantially the same invention which are allowable in all of the applications involved, in accordance with the provisions of these rules.

(c) Interferences will not be declared, nor continued, between applications or applications and patents owned by the same party unless good cause is shown therefor. The parties shall make known any and all right, title, and interest affecting the ownership of any application or patent involved or essential to the proceedings, not recorded in the Patent Office, when an interference is declared, and of changes in such right, title, or interest, made after the declaration of the interference and before the expiration of the time prescribed for seeking review of the decision in the interference.

204. Interference with a patent; affidavit by junior applicant. (a) The fact that one of the parties has already obtained a patent will not prevent an interference. Although the Commissioner has no power to cancel a patent, he may grant another patent for the same invention to a person who, in the interference, proves himself to be the prior inventor.

(b) When the effective filing date of an applicant is three months or less subsequent to the effective filing date of a patentee, the applicant, before the interference will be declared, shall file an affidavit that he made the invention in controversy in this country before the effective filing date of the patentee, or that his acts in this country with respect to the invention were sufficient to establish priority of invention relative to the effective filing date of the patentee.

(c) When the effective filing date of an applicant is more than three months subsequent to the effective filing date of the patentee, the applicant, before the interference will be declared, shall file two copies of affidavits by himself

and by one or more corroborating witnesses, supported by documentary evidence if available, setting out a factual description of acts and circumstances which would prima facie entitle him to an award of priority relative to the effective filing date of the patentee, and accompanied by an explanation of the basis on which he believes that the facts set forth would overcome the effective filing date of the patentee. Upon a showing of sufficient cause, an affidavit on information and belief as to the expected testimony of a witness whose testimony is necessary to overcome the filing date of the patentee may be accepted in lieu of an affidavit by such witness. If the examiner finds the case to be otherwise in condition for the declaration of an interference he will consider this material only to the extent of determining whether a date prior to the effective filing date of the patentee is alleged, and if so, the interference will be declared.

APPENDIX B

UNITED STATES COURT OF APPEALS

FOR THE DISTRICT OF COLUMBIA CIRCUIT

No. 20,297

FRANK PETER DOYLE, *et al.*,

Appellants,

v.

EDWARD J. BRENNER,
Commissioner of Patents,

Appellee.

Appeal from the United States District Court
for the District of Columbia

Decided July 21, 1967

Mr. Albert L. Jacobs, Jr., with whom *Messrs. Albert L. Jacobs and James W. Dent* were on the brief, for appellants. *Mr. James E. Bryan* also entered an appearance for appellants.

Mr. Joseph Schimmel, Solicitor, United States Patent Office, for appellee.

Before BAZELON, *Chief Judge*, McGOWAN and LEVANTHAL, *Circuit Judges*.

LEVANTHAL, *Circuit Judge*: This case arises out of proceedings in the Patent Office in which appellants applied for a patent involving phenoxacetylpenicillanic acid

(6-APA), a reagent in a penicillin producing process. After appellants' application was rejected as unpatentable, the District Court reversed a Patent Office determination that another application involving 6-APA, that of a Mr. Sheehan, was unpatentable on grounds of obviousness.[1] Accordingly, appellants asked for reconsideration of their rejection and for a declaration of interference with Sheehan. The Patent Office notified appellants that the prosecution of their application was being suspended pending a determination of whether to declare an interference. Then appellants were advised that a patent had been issued to Sheehan and that their application was finally rejected as unpatentable, the Sheehan patent being used as the critical reference against them.

The basis for this rejection was that the Sheehan patent described 6-APA and was entitled to a filing date earlier than the earliest date of conception claimed by appellants.[2] Although the Sheehan application had a filing date later than appellants', it was the continuation-in-part of a parent application, also describing 6-APA, having a filing date earlier than appellants. The examiner ruled the Sheehan patent was entitled to the filing date of the parent application.

Appellants argued that Sheehan was not entitled to the filing date of the parent because 6-APA, though mentioned in the parent application, had not actually been made at that time. The examiner agreed that applicants had made a prima facie showing that Sheehan had not made 6-APA

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[1] Massachusetts Institute of Technology v. Ladd, 231 F. Supp. 146 (1964).

[2] *See* 35 U. S. C. §102(e) (1964).

under the parent. He ruled, however, that in the absence of a conclusive showing by appellants overcoming his determination that Sheehan was entitled to the parent date, appellants' application was unpatentable over Sheehan, and no interference could be declared.

The Commissioner denied appellants' petition for review stating that the examiner's rejection of appellants' application on patentability grounds rather than declaring an interference was permissible under the interference rules, and that it was for the Patent Office Board of Appeals to decide whether the examiner had erred in concluding that appellants' application was unpatentable over the Sheehan patent. Appellants' action for review of the Commissioner's decision was dismissed by the District Court and they appeal.

Although the parties have briefed and argued the lawfulness of the procedure followed by the Patent Office,[3] which was apparently approved by the District Court, we affirm on the ground that the case is premature for judicial consideration, since there was no final agency action of the Patent Office.[4] Even assuming that the Commissioner's approval of the examiner's procedure in deciding patentability before priority is not subject to reconsider-

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[3] Appellee contends that the patentability of an application is a precondition to declaration of interference (*see* Patent Office Rule 201(b)), and that the examiner's approach of deciding patentability before priority has solid support in precedent. Brenner v. Manson, 383 U. S. 519, 528, n. 12 (1966); Application of Rogoff, 261 F. 2d 601, 606 (C. C. P. A. 1958). Appellants insist that the precedents involved bars to patentability on grounds other than the patent of the potential interferant, so that the applicants could not have gotten a patent even if they prevailed in the interference.

[4] Phillips Petroleum Co. v. Brenner, —— U. S. App. D. C. ——, —— F. 2d —— (No. 20626, June 29, 1967).

ation within the Patent Office,[5] this was only an interlocutory ruling in the consideration of appellants' application. Even assuming arguendo that appellants could sustain the burden of showing that the approach is an abuse of discretion or in violation of Patent Office rules,[6] the courts will not consider the problem until there is a final agency decree rejecting appellants' application for patent. As matters stand, appellants may still obtain a ruling from the Patent Office Board of Appeals that their claims are patentable. If their application is finally rejected, they will then be in a position to argue in court that rejection was the unlawful product of an improper and arbitrary procedure.

Affirmed

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[5] We have not tried to probe the limit of what we understand to be the general Patent Office approach that a board of appeals, being an adviser to the Commissioner, is not free to overrule his prior procedural determinations. We would hope, however, that there is a means available for a board of appeals, if it concluded that an imprudent procedural ruling by the examiner had seriously diluted substantive rights, to bring the matter before the Commissioner for a further look without feeling powerless even to initiate reconsideration merely because the Commissioner had earlier determined that the examiner's procedural ruling had not been shown to have been arbitrary, a determination made on a record limited to a bare procedural issue, without substantive perspective.

[6] *Compare* Newcastle Airport Comm'n v. CAB, —— U. S. App. D. C.——, 371 F. 2d 733 (1966).

We note that it seems to be established Patent Office practice, in a situation where an applicant requests an interference with a pending application and does not swear behind what the examiner deems to be the effective filing date of the potential interferant, for the Patent Office to issue a patent to the senior applicant and then use that patent as a patentability reference against the junior applicant. *See* Manual of Patent Examining Procedure §1101.01(i) (as revised July 5, 1965).

UNITED STATES DISTRICT COURT

FOR THE DISTRICT OF COLUMBIA

Civil Action No. 2928-65

FRANK PETER DOYLE,
JOHN HERBERT CHARLES NAYLER,

and

GEORGE NEWBOLT ROLINSON,

Plaintiffs,

—v.—

EDWARD J. BRENNER,
Commissioner of Patents,

Defendant.

ORDER

Upon consideration of defendant's Motion to Dismiss, memoranda of the parties relating thereto, and the oral arguments advanced at the hearing had the twenty-second day of March, 1966, it is this 25th day of March, 1966,

ORDERED, that the Motion to Dismiss be, and it is hereby granted, and that the Complaint be, and it hereby dismissed. See *Brenner* v. *Manson*, 148 USPQ 689, 693 (1966).

JOSEPH R. JACKSON
United States District Judge

U. S. DEPARTMENT OF COMMERCE
PATENT OFFICE
WASHINGTON

Address only
The Commissioner of Patents
Washington, D. C. 20231

Group 120
GM:aw

Ex parte Frank Peter Doyle et al.
Serial Number 826,491
Filed: July 13, 1959
For: Substances Produced From
Penicillin-Producing Moulds

Petition

This petition filed October 22, 1965 and stated to be under the provisions of Rules 181 to 183 seeks to have the Examiner directed to initiate an interference between this application and Sheehan Patent Number 3,159,617, petitioners having copied the claims of the said patent.

The Examiner's refusal to initiate an interference is based on his contention that the copied claims are unpatentable to petitioners in view of the Sheehan patent and its parent, abandoned application Serial Number 643,260.

It is clear that Rule 181 does not contemplate any direct review of a rejection by way of petition since rejections are subject to appeal to the Board of Appeals. Rule 181 does contemplate invoking the supervisory authority of the Commissioner in "appropriate circumstances". Review

of a rejection by way of petition would be appropriate only where the rejection is not presented in such form that its propriety could be properly reviewed by the Board of Appeals. In the present case the ground of rejection has been set forth and related to the Patent Laws. The Examiner has in his final rejection and subsequent actions commented on petitioners' arguments. A clear issue is thus presented for consideration by the Board of Appeals.

No specific argument has been made that the instant situation presents questions not provided for by the Rules or that are appropriate for suspension of any Rule, and it is not seen that Rule 182 or 183 are applicable.

Petitioners suggest that an interference might be declared and the question of patentability deferred. They state that they would have to prove that they would prevail in a determination of priority in order to overcome the rejection and then prove the entire case all over again during interference. While disclosure or evidence necessary to prove priority is not necessarily commensurate with that required to support allowance of a claim or to support rejection of a claim, it appears that petitioners' arguments should not forestall the application of Rules 201(b) and 205(a) to determine patentability first. Even if the Rules be construed as permissive of determining priority before patentability, it is neither apparent that such action is required by applicable Rules or Statutes nor that the Examiner has acted arbitrarily in the instant case to determine patentability first.

Petitioners refer to four "Questions Presented". Since these appear to relate to matters to be treated after the

conditions of Rules 201(b) and 205(a) are met, they do not appear controlling of this petition.

The petition is denied.

Sgd. G. D. MITCHELL
George D. Mitchell
Acting Director
Chemical Examining Operation

JACOBS AND JACOBS
521 Fifth Avenue
New York, New York

APPENDIX C

Paper No. 39

U. S. DEPARTMENT OF COMMERCE
PATENT OFFICE
WASHINGTON

Jacobs and Jacobs
521 Fifth Avenue
New York, New York

In Reply Please Refer To:

Applicant: Frank Peter Doyle et al.
Ser. No. 826,491
Filed: July 13, 1959
For SUBSTANCES PRODUCED FROM PENICILLIN-PRODUCING MOULDS

Please find below a communication from the EXAMINER in charge of this application.

Commissioner of Patents.

This is in response to the amendments received September 8 and 29, 1965.

Claims 1, 3-7, and 15-25 remain in the application.

Claims 3, 4, 15, 18, and 21 stand allowed.

Claims 1, 5-7, 16, 17, 19, 20, and 22-25 stand finally rejected as unpatentable over the Sheehan patent for reasons particularly pointed out in Paper No. 32.

Applicants argue that Sheehan is not a reference against them as of the filing date of the Sheehan parent since the sole example in the parent which supports the claims of the patent is subject to serious criticism from a technical standpoint. In other words, applicants question whether or not Sheehan actually made phenoxyacetylpenicillanic acid. If Sheehan did not make this product, *and this fact is proven,* then it would appear that Sheehan could not rely on the parent. If Sheehan can not rely on the parent then applicants will be entitled to contest priority of the invention via interference proceedings.

Therefore, we arrive at the basic issue which remains unchanged in spite of the affidavits submitted in support of applicants' position: Did Sheehan make phenoxyacetylpenicillanic acid? Sheehan presumably conducted the experiment or at least supervised it. He intended to make the product. The reactants which Sheehan employed *could* produce the desired product under the specified conditions. Sheehan, a skilled chemist working in the art, says he *did make the intended product.*

Affidavits submitted in support of applicants' position provide expert opinion as to why Sheehan did not produce the indicated product. While the affidavits present perfectly plausible explanations in support of applicants' position, they *have* to be based on *speculation.* Affiants cannot know for *certain* what Sheehan made.

Thus, the present status of the case is this: Unquestionably competent chemists have disagreed on the results of a chemical experiment. The one who *was there believes he produced a given product.* Those who *were not there believed the product was probably not produced* and, even if

it was produced, *its presence was not established by conclusive scientific procedures* so that its existence or non-existence will never be established as a matter of absolute fact.

Under the circumstances, logic would seem to dictate favoring the position of the trained observer-in-fact over the hypothesis of the trained non-observer.

Accordingly, applicants' position and the arguments and affidavits in support thereof are not deemed sufficient to overcome the Sheehan parent.

The Examiner is not unaware of the ramifications of this decision. First, the position taken by the Examiner is that in order for applicants to prevail, they must *conclusively* establish error in the Sheehan parent. This they probably can *never* do. The *best* that could be done is for applicants to present expert opinion to raise a *prima facie* question of error. It would appear that this burden been [sic] sustained.

Applicants undoubtedly consider the decision as harsh since, from their viewpoint, one who has erred is placed in a favored position because of the error. But, assuming that Sheehan did not err (and the rejection is based on this assumption), it would be equally harsh to put patentee to the expense of a costly interference proceeding simply because others hypothesize error. If there is doubt, doubt should be resolved in favor of the patentee.

It is also acknowledged that applicants cannot be said to be challenging the *validity* of a U. S. patent. They are challenging the *effective date* of the patent as a reference—a completely unrelated thing.

Moreover, it is further admitted that applicants wish to contest priority of a *generic* invention. If there is no support in a parent application of a U. S. patent for a generic inventive concept, the question arises whether a patent having claims directed to *a genus* can rely on a parent having no reference to the genus but only a species thereunder to give an earlier effective filing date to the generic invention.

However, applicant has presented no decisions on these points favorable to him. The decisions which are relied on do not deal with analogous factual circumstances, and therefore, are not controlling.

The law which appears to control is that of In re *Heritage,* 86 U. S. P. Q. 160, and Ex parte *Schacter,* 796 O. G. 881. These decisions hold that a parent abandoned application is a reference in the appropriate circumstances. Thus, the Sheehan parent, being a reference, renders the claims unpatentable to applicants. And if the claims are not patentable, it is axiomatic that there can be no interference. In re *Rogoff,* 120 U. S. P. Q. 185. Applicants' attempt to distinguish Rogoff on the grounds that it deals with non-chemical subject matter is not convincing.

Admittedly, the present fact situation is not on all fours with In re *Heritage, supra.* Here there is a question as to what the parent actually teaches. Even if the parent is available as a reference, it is in fact a valid reference? The rejection stems from a belief that it is a valid reference against the instant claims.

In view of the foregoing, the question of an interference is seen to be secondary to the *immediate* problem of patentability. It is this latter issue which is now on appeal to the Board. The decision of the Board in deciding patent-

ability will also determine the question of the interference. If the rejection is sustained, no interference can be declared. If the rejection is reversed, those claims which are allowed and which correspond to the claims of Sheehan can be placed in interference.

The application is being returned to the Board of Appeals to await perfection of the appeal.

NICHOLAS S. RIZZO
Examiner

JWAdams:meh
WO7-2805

M. P. E. P. §1101.02(a) COPYING CLAIMS FROM A PATENT

A large proportion of interferences with a patent arise through the initiative of an applicant in copying claims of a patent which has come to his attention through citation in an Office action or otherwise.

If, in copying a claim from a patent an error is introduced by the applicant, the Examiner should correct applicant's claim to correspond to the patent claim. A notation should be added to his letter (POL 76) stating that the correction has been made.

However, in some instances the Examiner observes that certain claims of a patent can be made in a pending application and, if the patent is not a statutory bar, he must take steps to avoid the issuance of a second patent claiming the same invention without an interference. The practice set forth hereinbelow applies when an issued patent and a pending application are not commonly assigned. If there is a common assignment, a rejection as outlined in

305 should be made if an attempt is made to claim in the pending application the same invention as is claimed in the patent.

A patent claiming the same invention as that being claimed in an application can be overcome only through interference proceedings. Where the effective filing date of the application is prior to that of the patented application, no oath is required. Otherwise the applicant must submit an affidavit that he made the invention prior to the filing date of the patent, even though there was copendency between the two applications. The affidavit may be made by persons other than applicant. Cf. 715.04. It is within the discretion of the Examiner to require the same showing of facts in an affidavit under Rule 204 as is required in an affidavit under Rule 131. This discretion should be governed by the circumstances of the case, such as the difference in filing dates, complexity of the invention, etc. However, in all cases where claims are copied from a patent, and the applicant's effective filing date is more than thirty days later than the patentee's filing date, the Examiner, before declaring an interference, shall require applicant to file an affidavit *setting forth sufficient facts to make out a prima facie case for priority relative to the filing date of the patentee.* (Basis: Notice of April 30, 1963.)

If the filing date of the patent precedes the filing date of the application and the patent is not a statutory bar against the application, the claims of the application should be rejected on the patent. If it appears that the applicant is claiming the same invention as is claimed in the patent and that the applicant is able to make one or more claims of the patent, a statement should be included in the

rejection that the patent cannot be overcome by an affidavit under Rule 131 but only through interference proceedings. Note, however, 35 U. S. C. 135, 2d par. and section 1101.02(f). If the applicant controverts this statement and presents an affidavit under Rule 131, the case should be considered special, one claim of the patent which the applicant clearly can make should be selected, and an action should be made refusing to accept the affidavit under Rule 131 and requiring the applicant to make the selected claim as well as any other claims of the patent which he believes find support in his application. If necessary, the applicant should be required to file the affidavit and showing required by Rule 204. A time limit for response should be set under Rule 203. In any case where an applicant attempts to overcome a patent by means of affidavit under Rule 131, even though the Examiner has not made a rejection on the ground that the same invention is claimed in the patent, the claims of the patent should be examined and, if applicant is claiming the same invention as is claimed in the patent and can make one or more of claims of the patent, the affidavit under Rule 131 should be refused, and an action such as outlined in the preceding part of this paragraph should be made. If necessary, the requirements of Rule 204 should be specified and a time limit for response should be set under Rule 203.